

**REMARKS**

Claims 1 through 12 are pending in this Application. Claims 1, 2, 5, 10 and 11 have been amended. Care has been exercised to avoid introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, page 7 of the written description of the specification lines 13 and 14 with respect to claims 1 and 2. Applicants note that claims 5 and 10 have been placed in independent form and that the amendment to claim 11 merely address a perceived antecedent basis issue. Applicants submit that the present Amendment does not generate any new matter issue.

**Drawing objection.**

In response to the Objection to the Drawings, formal drawings are submitted herewith as Exhibit A. Accordingly, withdrawal of the objection to the drawings is solicited.

**Claims 11 and 12 were rejected under the second paragraph of 35 U.S.C. §112.**

In the statement of the rejection, the Examiner asserted a perceived antecedent basis issue. This rejection is traversed.

Firstly, merely identifying a perceived antecedent basis issue does not automatically trigger a rejection under the second paragraph of 35 U.S.C. §112 for indefiniteness which is a legal issue. *Bose Corporation v. JBL, Inc.*, 274 F.3d 1354, 61 USPQ2d. 1216 (Fed. Cir. 2001). At any rate, claim 11 has been amended to address the perceived antecedent basis issue, with no intention to otherwise limit the scope of claim 11, thereby overcoming the stated basis for the rejection.

Accordingly, withdrawal of the rejection of claims 11 and 12 under the second paragraph of 35 U.S.C. §112 is solicited.

**Claims 1, 2 and 3 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Masuda et al.**

In the statement of the rejection the Examiner referred to Fig. 1 of Masuda et al. and to pages 139 and 142, asserting the disclosure of a Raman amplifier corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2003). There is a fundamental difference between the inventions defined in independent claims 1 and 2 and the Raman device disclosed by Masuda et al. that scotches the factual determination that Masuda et al. disclose a Raman amplifier identically corresponding to that claimed.

Specifically, the Raman pump unit of Masuda et al. consists of two stages. The first stage is for filtered ASE Light Generation and has EDFs, 1.48 $\mu$ m pump LD, etc. The second stage is an EDFA. The first stage corresponds to the pump light source 51 or 52 in the present invention (Figs. 1 through 3).

In the first stage of the Raman pump unit of Masuda et al., the pump LD emits light having the wavelength of 1.48 $\mu$ m, which is the pump wavelength of an EDFA. However,

the pump light source 51 or 52 emits light having a wavelength within the amplification waveband of an EDFA.

The above argued structural difference between the claimed Raman amplifier and the Raman unit disclosed by Masuda et al. undermines the factual determination that Masuda et al. disclose a Raman amplifier identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 2 and 3 under 35 U.S.C. §102 for lack of novelty as evidenced by Masuda et al. is not factually viable and, hence, solicit withdrawal thereof.

**Claims 1, 10 and 6 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Akasaka et al.**

In the statement of the rejection the Examiner asserted that Akasaka et al., in Fig. 1, disclose a Raman amplifier corresponding to that claimed. This rejection is traversed.

As previously pointed out, the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, *supra*; *Crown Operations International Ltd. v. Solutia Inc.*, *supra*. Moreover, in imposing a rejection under 35 U.S.C. §102, the Examiner is required to **specifically identify** wherein an applied reference is perceived to disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik*

*GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

That burden has not been discharged. Moreover, there is a fundamental difference between the claimed Raman amplifier and any Raman device disclosed by Akasaka et al. that scotches the factual determination that Akasaka et al. disclose a Raman amplifier identically corresponding to that claim.

In accordance with the claimed invention, the wavelength of the pump light is within the **amplification wavelength band of an EDFA**. This feature is neither disclosed nor suggested by Akasaka et al. In short, the wavelength of the pump light employed by Akasaka et al. is not within the **amplification waveband of an EDFA**. For example, adverting to column 14 of Akasaka et al., lines 18 through 20, the wavelength of 1435 nm and 1465 nm are employed. In column 19 of Akasaka et al., lines 49 through 54, the wavelengths of 1435 nm, 1450 nm and 1480 nm are disclosed.

The above argued structural difference between the claimed Raman amplifier and the Raman device disclosed by Akasaka et al. undermines the factual determination that Akasaka et al. disclose a Raman amplifier identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, *supra*; *Kloster Speedsteel AB v. Crucible Inc.*, *supra*. Applicants, therefore, submit that the imposed rejection of claims 1, 10 and 6 under 35 U.S.C. 102 for lack of novelty is evidenced by Akasaka et al. is not factually viable and, hence, solicit withdrawal thereof.

Applicants acknowledge, with appreciation, the Examiner's allowance of claims 4 and 7 through 9, and the Examiner's indication that claim 5 contains allowable subject matter. Claim 5 has been placed in independent form. Based upon the arguments herein, it

should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read 'M/S Steiner', is written over the printed name.

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